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JAECKLE FLEISCHMANN & MUGEL, LLP
190 LINDEN OAKS
ROCHESTER NY 14625-2812

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

In re Application of
JOHN BROWNIE et al.
U.S. Serial No.: 10/522,513
PCT Application No.: PCT/GB03/02832
Int. Filing Date: 01 July 2003
Priority Date: 27 July 2002
Attorney Docket No.: 10069.0006US1
For: CANINE RESPIRATORY
CORONAVIRUS (CRCV)....

DECISION ON PETITION TO
WITHDRAW HOLDING OF
ABANDONMENT

This is in response to applicants' "Request for Reconsideration of Decision on Petition to Withdraw the Holding of Abandonment", filed in the United States Patent and Trademark Office (USPTO) on 11 September 2006 in the above referenced application.

It is noted that a revocation and power of attorney in this application was filed on 27 September 2006 and has been recorded in the USPTO. This decision is directed to both the previous law firm and the current law firm because the request for reconsideration was filed by the previous law firm, whose records are at issue in this matter.

BACKGROUND

On 26 September 2005, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration was not in compliance with 37 CFR 1.497(a) and (b). On 21 November 2005, applicants filed an executed declaration.

On 7 February 2006, a Notification of Defective Response (Form PCT/DO/EO/916) was mailed to applicant indicating that the declaration did not identify the citizenship of each inventor and thus, was not in compliance with 37 CFR 1.497(a) and (b).

On 23 May 2006, applicant made a status inquiry regarding this application using PAIR and discovered that the Notification of Defective Response had been issued on February 7, 2006. Petitioner contacted the PCT Help Desk to inquire about the status of the application, and was advised that the application was abandoned for failure to respond to the 07 February 2006 Notification of Defective Response.

On 02 June 2006, applicant filed a Petition to Withdraw the Holding of Abandonment along with docket record for the instant application. On 22 June 2006, applicant filed a response to Notification of Defective Response along with a newly executed declaration.

On 25 August 2006, a decision dismissing applicant's petition was mailed indicating that Petitioner had not provided sufficient evidence of the nonreceipt of an Office action.

On 11 September 2006, Petitioner filed "Request for Reconsideration of Decision on Petition to Withdraw Holding of Abandonment".

DISCUSSION

Applicant petitions to withdraw the holding of abandonment for failure to timely respond to the Notification of Defective Response, which he alleges was never received until it was sent via facsimile by the PCT Help Desk.

As stated in the decision mailed on 25 August 2006, in order to establish that papers were not received, as set forth in the Official Gazette at 1156 OG 53, applicant must provide the following: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket records must also be referenced in practitioner's statement). *See* MPEP §711.03(c).

Counsel has now satisfied Item (1) with the statement: "Practitioner did not receive the Office action dated Feb. 7, 2006 until it was faxed to the Practitioner by the PCT Help Desk on May 25, 2006 at the request of the Practitioner."

Item (2) above is not yet satisfied because counsel states that a search of the file jacket and docket record for the **subject application** was conducted. What is required is a search of the file jacket and a search of the **law firm's docket records**. A search of the law firm's docket record for the date that a response was due (07 March 2006) is required to show that the Office action was not received at the correspondence address of record. It is possible that the Office action was received by the docketing department but never recorded in the docket record for the instant application file. Likewise, the docket record for a single attorney does not provide evidence that the Office action was not received at the correspondence address of record.

The MPEP provides the following example: "if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action."

With regard to item (3), Counsel's assumption that the reference in the decision to "docket records of the firm means docket records for all application the firm is handling" is correct. However, applicant resubmitted the docket record for the instant application to show the non-receipt of the 07 February 2006 Notification rather than the law firm's docket record.

A single document containing only docket information on the U.S. application in question shows no other corroborating information to add weight and credibility to the information contained therein and can be too easily manipulated. In order to satisfy the docket record requirement to prove nonreceipt of an Office communication, applicant must provide a copy of counsel's docket records for the date upon which a response to the Notification of Defective


Response was due (*i.e.*, 07 March 2006). An example of such a record would be a daily "tickler" report or a daily log showing all applications for which a response is due on that date. The docket report showing only the subject application does not satisfy this requirement.

CONCLUSION

For the reasons discussed above, the petition under 37 CFR 1.181 is **DISMISSED WITHOUT PREJUDICE**. The application remains **ABANDONED**.

Applicant should submit a true copy of the docket record where the non-received Office action would have been entered had it been received (that is, the docket record for 07 March 2006) and should be referenced in the practitioner's statement.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3286